



IPW

PATENT

Docket No. 1232-5188

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s) : SHIMOYAMA
Serial No. : 10/697,179 Art Unit : 2853
Filed : October 29, 2003 Examiner : R. Garcia, Jr.
For : INK JET PRINTING APPARATUS AND INK JET PRINTING
METHOD

RESPONSE TO ELECTION OF SPECIES REQUIREMENTS

Mail Stop - Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Kindly consider the following election in response to the June 30, 2005 election of species requirements.

ELECTION:

The Examiner, in the June 30, 2005 election of species, requires election of one of the following two distinct species:

Species I, Ink jet printing apparatus and method with determining means based on the amount of ink per unit area of printing medium; and

Species II, Ink jet printing apparatus with determining means based on the spacing between print medium and a print head.

Applicants respectfully traverse the above election of species requirements as being improper and request withdrawal thereof.

Section 803 of the Manual of Patent Examining Procedure (MPEP) indicates that “there are two criteria for restriction between patentably distinct inventions” as follows to wit:

- “(A) The inventions must be independent...; and,
- (B) There must be a serious burden on the examiner if restriction is not required....”

Applicants respectfully submit that Species I and II are properly presented in the same application and that no serious burden on the Examiner exists. The Examiner has not provided any evidence or line of reasoning to show that the identified species are independent and that a serious burden exists. As such, the Examiner has not satisfied the two criteria identified in Section 803 of the MPEP. Notwithstanding any actual independence or distinction between the identified species, Section 803 of the MPEP requires examiners to search and examine application containing independent or distinct invention when no serious burden to do so exists. Section 803 of the MPEP also states that:

“If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.”

The Examiner has not provided any specific discussion, line of reasoning, and/or evidence to support his conclusion that a serious burden, in fact, exists.

In view of the above discussion, it is respectfully submitted that the election of species requirement is improper and should be withdrawn. Accordingly, action on the merits for Species I and II is respectfully requested.

Notwithstanding the above discussion, Applicant hereby elects Species 1. Applicant

respectfully submits that Claims 1 and 3-10 are readable on elected Species I. Applicants, nonetheless, reserve the right to file divisional applications based on the non-elected species and claims directed thereto.

AUTHORIZATIONS:

The Commissioner is hereby authorized to charge any additional fees which may be required for the timely consideration of this amendment, or credit any overpayment to Deposit Account No. 13-4500, Order No. 1232-5188.

Respectfully submitted,
MORGAN & FINNEGAN, L.L.P.

Date: July 29, 2005

By: 

Brian W. Brown
Reg. No.: 47,265
(202) 857-7887 Telephone
(202) 857-7929 Facsimile

Correspondence Address:
Morgan & Finnegan
Three World Financial Center
New York, NY 10281-2101
(212) 758-4800 Telephone
(212) 751-6849 Facsimile